

### **Remarks**

The invention is directed at a method lubricating the interface between a container and a moving conveyor surface, in the substantial absence of foamed lubricant and lubricant runoff. The method includes steps of forming a continuous thin film on a container contact surface of a conveyor and moving a container on the conveyor contact surface in order to transport the container from a first location to a second location. The continuous film includes an emulsion lubricant composition comprising an oil phase and an aqueous phase, wherein the oil phase comprises silicone. The Applicants discovered that by providing an emulsion lubricant composition containing silicone, it is possible to provide a continuous thin film on a container contact surface of a conveyor while avoiding the presence of foamed lubricant and lubricant runoff.

### **Prior Art-Base Rejections**

Claims 1, 5, 9, 12-14 and 16 stand rejected under 35 U.S.C. § 102(b) over International Publication No. WO 93/18120 to Henkel. In view of the above amendment incorporating the features of claim 2 into claim 1, it is submitted that this rejection has been rendered moot. Accordingly, withdrawal of this rejection is requested.

Claim 1-5, and 9-16 stand rejected under 35 U.S.C. § 103(a) over Henkel and U.S. Patent No. 5,352,376 (Gutzmann). This rejection is transversed.

It is submitted that the outstanding Office Action recognizes that Henkel fails to anticipate claim 1 of the above-identified patent application. Gutzmann would not have suggested modifying Henkel to achieve a method of lubricating the interface between a container and a moving conveyor surface, in the substantial absence of foamed lubricant and lubricant runoff, according to the present invention. The method according to the present invention includes step of forming a continuous thin film of an emulsion lubricant composition on a container contact surface of a container, and moving a container on the conveyor surface in order to transport the container from a first location to a second location. According to the present invention, the emulsion lubricant composition comprises an oil phase and an aqueous phase, wherein the oil phase comprises silicone.

One having ordinary skill in the art would not have received the suggested from Gutzmann to modify Henkel to achieve the presently claimed invention. For example, it is not seen how Gutzmann would have suggested modifying Henkel to provide an emulsion lubricant

composition comprising an oil phase and an aqueous phase, wherein the oil phase comprises silicone.

In view of the above comments, withdrawal of the rejection over Henkel and Gutzmann is requested.

Claims 6-8 and 17-20 stand rejected under 35 U.S.C. § 103(a) over Henkel, Gutzmann, and U.S. Patent Publication No. US2002/0025912 (Person Hei et al. '912). This rejection is traversed.

It is submitted that Person Hei et al. '912 fails to cure the defect identified above with respect to Henkel and Gutzmann. In particular, it is not seen how Person Hei et al. '912 would have suggested modifying Henkel or Gutzmann to achieve the presently claimed method of lubricating the interface between a container and a moving container surface, in the substantial absence of foam lubricant and lubricant runoff, comprising forming a continuous film of an emulsion lubricant composition on a container contact surface of a conveyor, and moving a container on the conveyor surface in order to transport the container from a first location to a second location, wherein the emulsion lubricant composition comprises an oil phase and an aqueous phase, wherein the oil phase comprises silicone.

In view of the above comments, withdraw of the rejection over Henkel, Gutzmann and Person Hei et al. '912 is requested.

#### Obviousness-Type Double Patenting Rejections.

The outstanding Office Action includes four obvious-type double patent rejections. Claims 1-20 stand rejected under the Doctrine of Obviousness-Double Patenting over claims 8-24 of U.S. Patent No. 6,806,240. Claims 1-20 stand rejected under the Doctrine of Obviousness-Double Patenting over claims 36-52 of U.S. Patent No. 6,673,753. Claims 1-20 stand rejected under the Doctrine of Obviousness-Double Patenting over claims 1, 2, 4, 5, and 8-20 of U.S. Patent No. 6,727,826. Claims 1-20 stand provisionally rejected under the Doctrine of Obviousness-Double Patenting over claims 36-52 of U.S. application Serial No. 10.614,474.

In view of the amendments to the claims, the Examiner is requested to reconsider these obviousness-double patenting rejections. If the Examiner decides to reject any of the amended claims under Doctrine of Obviousness-Double Patenting, a decision will be made to either file or not file a terminal disclaimer.

The outstanding Office Action appears to include a rejection of claims 1-20 under 35 U.S.C. § 103(a) over claims 36-52 of U.S. Patent No. 6,673,753. The ground for this rejection is not understood in view of the explanation provided in the outstanding Office Action. In view of the amendment to claim 1, the Examiner is requested to reconsider this rejection. It is submitted that the present invention would not have been obvious from U.S. Patent No. 6,673,753, and withdrawal of this rejection is requested.

Furthermore, the outstanding Office Action includes a provisional rejection of claims 1-20 under 35 U.S.C. § 103(a) over U.S. application Serial No. 10/614,474. The Examiner is requested to reconsider this provisional rejection in view of the amendment to claim 1. Furthermore, because the rejection is "provisional" it is understood that there is no actual rejection. If the Examiner wishes to issue an actual rejection, it is understood that the Examiner will wait until U.S. application Serial No. 10/614,474 issues as a patent.

#### Rejection Under 35 U.S.C. § 112, Second Paragraph

Claims 2, 3, 10, 11 and 18-20 stand rejected under 35 U.S.C. § 1.12, second paragraph. In view of the above amendment to the claims, it is submitted that this rejection has been rendered moot.

The antecedent basis issue in claim 2 has been resolved by the cancellation of claim 2.

Claims 18 and 20 are amended to address the issues identified with respect to claims 18, 19 and 20.

In view of the above amendments, withdrawal of the rejection under 35 U.S.C. § 1.12, second paragraph is requested.

#### Objection to Declaration

The outstanding Office Action objects to the declaration of the grounds that there is a discrepancy between the title of the invention listed on the Declaration and the title of the invention provided on page 1 of the above-identified patent application. The basis for this objection is that the "specification to which the oath or declaration is directed has not been adequately identified." It is submitted that this statement is simply incorrect. The Declaration was filed during the prosecution of U.S. application Serial No. 09/595,835, and the Declaration clearly refers to U.S. application Serial No. 09/595,835. According to the specification of the above-identified patent application on page 1, the above-identified application claims priority to

U.S. application Serial No. 09/595,835. Accordingly, the Declaration clearly identifies the specification to which it applies irrespective of the typographical error in the title.


In view of the above comments, withdrawal of the objection to the Declaration is requested.

It is believed that this application is in condition for allowance. Early notice to this effect is earnestly solicited.

Respectfully submitted,

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